

Appl. No. 09/627,254
Amndt. dated July 16, 2003
Reply to Office Action of April 17, 2003

REMARKS/ARGUMENTS

A. AMENDMENTS

1. Claims

Claim 1 has been amended to recite that the radio is capable of displaying a message indicating the status of the communication connection. Support for this amendment may be found in Applicants' application for invention in the first full paragraph of page 5. No new matter has been added.

Claims 4, 6 and 7 have been amended to be consistent with claim 1 and to resolve an antecedent basis problem. Support for this amendment may be found in Applicants' application for invention in paragraph 1 of page 3. No new matter has been added.

Claim 13 has been amended to include claim number "5" so as to resolve a dependency problem. Support for this amendment may be found in Applicants' application for invention in the second full paragraph of page 6. No new matter has been added.

Claims 17-24 are additional claims which are believed to be allowable. Support for these claims may be found in Applicants' application for invention. No new matter has been added.

B. REMARKS on Comments, Objections and Rejections

1. Comments

In considering the patentability of Applicants' claims under 35 U.S.C. 103(a), the Examiner was correct in his presumption that the subject matter of the various claims was

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commonly owned by the named inventors at the time the inventions covered in the various claims were made.

2. Objections

Responsive to the Examiner's objection to claims 4, 6, 7 and 13 for informalities, Applicants have amended each of the claims to correct the informalities noted by the Examiner. Specifically, Applicants have changed the term "communications" to "communication," which makes the term consistent with the term used in claim 1 and ensures that the term, as used in claims 4, 6 and 7, has a proper antecedent basis in claim 1. Regarding claim 13, Applicants have corrected the typographical omission and included claim number "5" to indicate the claim from which claim 13 depends.

3. Rejections

Claims 1-16 are pending in the application. The Examiner has rejected claims 1, 2 and 4 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,711,012 to Bottoms et al. ("Bottoms"), in view of U.S. Patent No. 5,898,920 to Jacobs ("Jacobs"). Applicants have amended claim 1.

Responsive to the rejection of claim 1 as being unpatentable over Bottoms in view of Jacobs, Applicants submit that the combination of Bottoms and Jacobs does not disclose, teach or suggest every element of amended claim 1. Not only does Bottoms fail to disclose, teach or suggest a communication port having a controller for communicating transmission signals to a radio including *signals having information about the status of a communication connection between the personal digital assistant and the cellular phone*, but Bottoms also fails to disclose,

teach or suggest *software for the microprocessor including both instructions for determining the status of a communication connection between the personal digital assistant and the cellular phone and instructions for displaying the status of the communication connection on the display.*

The Examiner cites column 4, lines 14-56 and Figs. 1-3 of Bottoms as teaching relevant elements of Applicants' amended claim 1. While the cited portion of Bottoms discloses that CPU 125 enables data encoder 155, modulator 145, demodulator 135 and data decoder 140 via control signals, and teaches a cellular transceiver 240 that provides a received QAM signal to demodulator 135, which then provides an encoded data stream to data decoder 140, data decoder 140 decoding the data and providing the received signal to DTE port 115 for transmission to DTE 10, the Bottoms reference does not teach the relevant elements of Applicants' amended claim 1. Bottoms does not disclose, teach or suggest a communication port that transmits to a radio signals having information about the status of a communication connection between a personal digital assistant and a cellular phone. Indeed, Bottoms does not disclose, teach or suggest that PSTN port 105, which Examiner interprets as being equivalent to the communication port of Applicants' amended claim 1, transmits information about the status of a communication connection between DTE 10 and cellular phone 200 to SVD modem 100 (interpreted by the Examiner as being equivalent to the radio of Applicants' claim 1).

Also, as recognized by the Examiner in rejecting claim 8, Bottoms does not teach the element of Applicants' amended claim 1 reciting *instructions for displaying the status of the communication connection on the display.* Though Examiner has interpreted SVD modem 100 as being equivalent to the radio of Applicants' amended claim 1, Bottoms does not teach that SVD modem 100 is capable of displaying information which indicates the status of a communication connection. In rejecting claim 8, Examiner stated that "... the combination of

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Bottoms in view of Jacobs and further in view of Pardo [U.S. Patent No. 6,266,539] fails to explicitly teach the steps of specifically displaying a message on the radio... ." Applicants submit that while Pardo shows the capability of displaying dialing messages, Pardo only teaches a PDA capable of displaying such messages. Pardo does not disclose, teach or suggest the elements of Applicants' amended claim 1, specifically a radio system including a radio having a microprocessor, a display and a connector for connecting to a personal digital assistant, the system including a modem incorporated into the radio and having means for connecting to the personal digital assistant; a communication port having access to the modem and the cellular phone, the communication port having a controller for communicating transmission signals to the radio which include signals having information about the status of a communication connection between the personal digital assistant and the cellular phone, and software for the microprocessor including both instructions for determining the status of a communication connection between the personal digital assistant and a cellular phone and instructions for displaying the status of the communication connection on the display. Further, Pardo provides no motivation for the use of a radio including software having instructions for displaying the status of a communication connection because the invention disclosed in Pardo is geared towards a telephone docking station for a PDA and not a radio system.

Claims 2 and 4 directly depend from amended claim 1 and, as described above, the combination of Bottoms and Jacobs does not teach, disclose or suggest all of the elements of the radio system of Applicants' amended claim 1. For the reasons stated above regarding independent claim 1, Applicants submit that dependent claims 2 and 4 are distinguishable over the cited prior art.

Claims 3 and 5-16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bottoms in view of Jacobs and further in view of Pardo. Claim 3 indirectly depends from

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amended claim 1 and incorporates the elements of claim 1. For the reasons stated above regarding claim 1, Applicants submit that dependent claim 3 is distinguishable over the cited prior art.

Responsive to the rejection of claim 5 as being unpatentable over Bottoms in view of Jacobs and further in view of Pardo, Applicants' submit that the combination of Bottoms, Jacobs and Pardo does not meet all of the steps of claim 5, namely determining the existence of a computer connection for the transfer of data between the personal digital assistant and the cellular phone, monitoring for a loss of connection or a hang up signal from the personal digital assistant, and ending the audio channel connection upon loss of connection or receipt of the hang up signal. The Examiner partially recognized the shortcomings of Bottoms and Jacobs by stating in the Office Action that "[t]he combination of Bottoms and Jacobs fail to explicitly teach monitoring for a loss of a connection or a hang up signal from the PDA and ending the audio connection upon loss of connection or receipt of the hang up signal."

To overcome these shortcomings, the Examiner has combined Bottoms and Jacobs with Pardo and concluded that it would have been obvious to one of ordinary skill in the art to combine Pardo with Bottoms and Jacobs to render Applicants' claim 5 obvious. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Pardo teaches a docking arrangement in conjunction with a basic telephone circuit that exploits all of the resident intelligence of a PDA in conjunction with the telephone circuit. As indicated in Pardo at column 4, lines 56-64, software installed on the PDA implements *desired* communications functions, including the receipt and transmission of email, the ability to access electronic networks, the ability to allow dialing from the PDA's address

book, from Web pages, and from email messages containing telephone numbers, and the ability to provide a convenient means to use various custom local area signaling services.

Pardo does not teach that the *desired* communications functions installed on the PDA via software includes the functions recited in the steps of Applicants' claim 5, including: determining the existence of a computer connection for the transfer of data between the PDA and a cellular phone, monitoring for a loss of connection or a hang up signal from the PDA, and ending an audio connection upon loss of connection or receipt of the hang up signal.

Pardo further teaches that because most of the cost of production of the patentee's inventive system is required to manufacture the PDA, the invention migrates all required communications functionality to the PDA in the form of software (column 5, lines 12-15). Accordingly, any additional functionality added to the system taught by Pardo would be implemented in the software at a great cost, therefore providing *no motivation* to combine the teachings of the Pardo reference with other prior art references to teach Applicants' inventive method, as recited in Applicants' claim 5. Consequently, although Examiner has argued that the combination of this reference with Bottoms and Jacobs renders Applicants' claim 5 obvious, Applicants' submit that none of the references provide a motivation to do so, and Pardo actually provides motivation against adding further communications functionality to the inventive system taught in that reference.

Responsive to the rejection of claims 6, 7, 8, 9, 10, 11, 12, 13, 14, 15 and 16 as being unpatentable over Bottoms in view of Jacobs and further in view of Pardo, Applicants submit that each of these claims depend either directly or indirectly from independent claim 5 and incorporate the elements of claim 5. Because the combination of these references do not teach or

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suggest every step claim 5, as described above, Applicants' submit that claims 6-16 are distinguishable over the cited prior art.

New Claims 17-19 are allowable over any combination of the cited prior art of record because no combination of the art of record discloses, teaches or suggests determining the status of a communication connection between the personal digital assistant and the cellular phone through the modem and displaying the status of the communication connection on the display. New Claims 20-24 are allowable over any combination of the cited prior art because no combination of the art of record discloses, teaches or suggests a communication port having a controller for communicating transmission signals to said radio including signals having information about the status of a communication connection between the personal digital assistant and the cellular phone.

III. CONCLUSION

For all of the above reasons, Applicants submit that claims 1, 2 and 4 are not disclosed, taught or suggested by the combination of Bottoms and Jacobs, and that claims 5-16 are not disclosed, taught or suggested by the combination of Bottoms, Jacobs and Pardo, thereby placing the application in condition for allowance. New Claims 17-24 particularly and distinctly claim the present invention as distinguished from the art of record. Applicants respectfully requests allowance thereof.

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Should any questions concerning any of the foregoing arise, the Examiner is invited to telephone the undersigned at (317) 237-1184.

In the event that Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefore and authorize that any charges be made to Deposit Account No. 02-0390, BAKER & DANIELS.

Respectfully submitted,



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CERTIFICATE OF MAILING
(37 C.F.R. § 1.8(a))

I hereby certify that, on the date shown below, this correspondence is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the address above on the date indicated below.

July 16, 2003

By: 

Kareem A. Howell